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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,459	12/22/2004	Mika Watanabe	MARU.001	5043

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MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC  
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VIENNA, VA 22182-3817

EXAMINER
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PETERSON, KENNETH E

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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06/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/518,459	Applicant(s) WATANABE, MIKA	
	Examiner Kenneth E. Peterson	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>22dec04</u> . | 6) <input type="checkbox"/> Other: _____  |

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1. Applicant's election with traverse of group I in the reply filed on 03 May 07 is acknowledged. The traversal is on the ground(s) that the search burden would be minimal. This is not found persuasive because the search for each of these features is different. The search for group I is on 83/687,691. The search for group II is on 83/588. The search for group III would be in 83/686. Group IV is 83/522.15. Group V is searched in 83/167. Group VI may be found in 83/468.1.

Indicative of the divergent search is the fact that the reference employed below (Growth) does not have any of the features of the non-elected groups. Numerous different types of text searching and subclass searching would have to be conducted to examine all of the groups. Furthermore, the post-search examination procedure of each group would be an extra burden. If rejoined, and prosecution went to appeal, Examiner would have to effectively write 6 different examiner's answers which would consume a weeks worth of time, far more than the time the office allots for this type of case.

Furthermore, a cursory review of the non-elected groups shows that Applicant correctly elected the group that is most in line with the thrust of the invention. Applicant's contention that divisional cases will be filed for some of the non-elected groups is taken skeptically, since they appear to be extraneous features.

If, at a later time, Examiner determines that rejoinder is non-burdensome he will do so. Possibly an independent claims can be drafted that is allowable, which would trigger rejoinder as per paragraph 1 of the previous action.

Applicant is reminded that the goal of restriction practice is keep costs down for Applicant, whose cooperation is appreciated.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicant's amendments to the claims, filed 22 Dec 04, failed to underline the new limitations. Future failure to do so may result in the amendment being held non-responsive.

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Applicant mistakenly used the phrase "material to examination". Also, the asterisk after 1.56\* refers only to 1.56a,b, when it should refer to all sections of 1.56. Alternately, the asterisk and footnotes can just be omitted.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Near the end of claim 1 is the phrase "*to lower said punch blade group from above said top base*". However, the punch blade group never starts above the top base (see Applicant's figure 2C), so it is not clear what limitation is intended here.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Groswith, III et al. (5,163,350), who shows a punching mechanism with all of the recited limitations including;

An operation part (37),

A punch blade group (26,31),

A rotational axis (best seen in figures 4 and 5),

A top base (27),

A bottom base (25),

A slot (having workpiece 5 therein, figure 8).

As seen in figure 5, the punches are close enough together to effectively destroy information on the workpiece.

With regards to claims 2, it is required that each punch blade (31) have a diameter. While Groswith's blades are not circular, Examiner notes that the term "diameter" can be employed with any shape to indicate a line passing thru the center of

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that shape (see Webster's II dictionary). Accordingly, each of the rectangular cross-section punch blades (31) has a diameter.

Growth does not explicitly state the diameter of his punch blades (31), but does say that the device is 40cm (400mm) long (line 25, column 5). Looking at figure 5, this means that each blade has a diameter of roughly 10mm, clearly with the recited range. Also seen in figure 5 is the fact that the gap between the blades is smaller than the diameter of the blades.

8. Made of record but not relied on is a patent to Drzewiecki showing a pertinent punching machine.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth E. Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

kp



KENNETH E. PETERSON  
PRIMARY EXAMINER